

REMARKS

Claims 1, 7, 8, 14, 16, 20, 21, 38, 41-43, 55-57, 60, 61, 63-67, 70-76 and 82-93 are pending in this application, with claims 1, 14, 67, 72, 76, 83, 89 and 91 being independent. Claims 1, 7, 14, 20, 21, 38, 41, 43, 56, 57, 60, 63, 64, 67, 70 and 76 have been amended; claims 39, 40, 58, 59, 62, 68 and 69 have been canceled; and claims 82-93 have been added. Support for the amendments and the new claims can be found in the published application (U.S. Patent Application Publication No. 2004/0172455) at least at Figs. 6 and 7 and their accompanying text. No new matter has been introduced.

Independent claims 1, 14, 67, and 72, and various of their dependent claims, have been rejected as being unpatentable over Tang (U.S. Patent No. 6,791,583) in view of Imamura (U.S. Patent Application Publication No. 2002/0091774). Dependent claims 7, 8, 21 and 42, which depend from claims 1 and 14, have been rejected as being unpatentable over Tang in view of Imamura and Widger (U.S. Patent Application Publication No. 2005/0117733). Dependent claims 38, 43, 65, and 66, which depend from claim 14, have been rejected under 35 U.S.C. 103(a) as being unpatentable over Tangs in view of Imamura and Lee (U.S. Patent Application Publication No. 2003/0233265). Dependent claims 41, 68, 69, 74 and 75, which depend from claims 14, 67 and 72, have been rejected as being unpatentable over Tang in view of Imamura and Nielsen (U.S. Patent No. 6,108,688).

Independent claim 1, as amended, recites, among other features, a computer-readable storage medium having embodied thereon a computer program that includes instructions that cause a computer to determine a number of unread e-mail messages sent by a first one of the co-users to the user that remain unread by the user; and conditioned on the number of unread e-mail messages being greater than zero, display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have been sent by the first co-user to the user and remain unread by the user. A selection of the first graphical element by the user is received and, in response to the selection, the number of unread e-mail messages sent by the first co-user to the user that remain unread by the user are displayed. Independent claim 14, while having a different scope from that of claim 1, recites limitations similar to those recited by claim 1 but does so in the context of a method. Applicants request reconsideration and withdrawal of the

rejections of claims 1 and 14, and their dependent claims, because neither Tang, Imamura, Widger, Lee, Nielsen, nor any proper combination of the five describes or suggests displaying, within the recited window and in association with an identifier corresponding to a co-user of an instant messaging system displayed in a contacts list in the window, a first graphical element that indicates that one or more unread e-mail messages have been sent by a co-user to the user, the display of the first graphical element being conditioned on the number of unread e-mail messages being greater than zero, AND the conditionally displayed first graphical element being selectable by the user to display the number of unread e-mail messages sent by the co-user to the user.

The Office Action asserts that Tang's icon 64 displayed next to a displayed user identifier in Tang's contact list corresponds to the recited first graphical element. However, the display of Tang's icon 64 is not conditioned on a number of unread e-mail messages sent to the user by a co-user corresponding to the displayed user identifier being greater than zero. Rather, the display of Tang's icon 64 is conditioned on the co-user corresponding to the displayed user identifier viewing information regarding the user's activities. See col. 12, lines 6-9.

Applicants note that while selection of the user identifier in Tang's contact list by the user can result in a display of an information window 62 that includes an envelope icon 62b that indicates a number of unread e-mail messages received by the user from the co-user (see Fig. 5A, and col. 11, lines 17-31), the user identifier cannot correspond to the recited first graphical element because the display of the user identifier is not conditioned on a number of unread e-mail messages sent to the user by the co-user corresponding to the displayed user identifier being greater than zero. Rather, the display of the user identifier in the contact list is only conditioned on the user having chosen to include the user identifier in his or her contact list.

Imamura, Widger, Lee and Nielsen also fail to describe or suggest the above-noted limitations.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1 and 14, and their dependent claims.

Independent claim 67, as amended, recites, among other features, a computer-readable storage medium having embodied thereon a computer program that includes instructions that cause a computer to "display, within the interface that includes the contacts list and in association

with the identifier in the list corresponding to the first co-user, a graphical element that displays the number of unread e-mail messages sent by the user to the first co-user that remain unread by the first co-user. " Applicants request reconsideration and withdrawal of the rejections of claim 67 and its dependent claims because neither Tang, Imamura, Widger, Lee, Nielsen, nor any proper combination of the five describes or suggests this feature.

Tang does not describe or suggest displaying a graphical element in association with an identifier in a contact list that displays the number of unread e-mail messages sent by a user perceiving the contact list to a co-user corresponding to the identifier that remain unread by the co-user. Rather, Tang describes user selection of a user identifier in Tang's contact list that triggers display of an information window 62 that includes an envelope icon 62a that indicates a number of unread e-mail messages received by the user from the co-user (see Fig. 5A, and col. 11, lines 17-31). Imamura, Widger, Lee and Nielsen also fail to describe or suggest the above-noted limitation.

For at least this reason, applicants request reconsideration and withdrawal of the rejection of claim 67 and its dependent claims.

Independent claim 72 recites, among other features, a computer-readable storage medium having embodied thereon a computer program that includes instructions that cause a computer to: " conditioned on determining that unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access, display within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access" and "conditioned on determining that no unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access, not display within the window and in association with the identifier corresponding to the first co-user any graphical element related to e-mails or e-mail inbox content" (emphasis added). Applicants request reconsideration and withdrawal of the rejections of claim 72 and its dependent claims because neither Tang, Imamura, Widger, Lee, Nielsen, nor any proper combination of the five describes or suggests these features.

As stated above, the Office Action asserts that Tang's icon 64 displayed next to a displayed user identifier in Tang's contact list corresponds to the recited first graphical element.

However, the display of Tang's icon 64 is not conditioned on a number of unread e-mail messages sent to the user by a co-user corresponding to the displayed user identifier being greater than zero or on a number of unread e-mail messages sent to the co-user by the user being greater than zero. Rather, the display of Tang's icon 64 is conditioned on the co-user corresponding to the displayed user identifier viewing information regarding the user's activities. See col. 12, lines 6-9. Imamura, Widger, Lee and Nielsen also fail to describe or suggest the above-noted limitations.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claim 72 and its dependent claims.

Independent claim 76 has been rejected as being unpatentable over Tang in view of Nielsen.

Independent claim 76 recites, among other features, "receiving an e-mail message addressed to the user from a first co-user, the user having no unread e-mail messages received from the first co-user prior to receipt of the e-mail message", "in response to the e-mail message, automatically displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages received by the user from the first co-user are available for access by the user" and "wherein no graphical element related to e-mails or e-mail inbox content was displayed in the window in association with the identifier corresponding to the first user prior to receipt of the e-mail message." Applicant's request reconsideration and withdrawal of the rejection of claim 76 because neither Tang, Nielsen, nor any proper combination of the two describes or suggests these features.

Tang does not describe or suggest automatically triggering display of a graphical element in a displayed instant messaging contact list in response to unread e-mail messages and, therefore, does not describe or suggest the above-noted features. As stated previously, the display of icon 64 is automatically triggered in response to the accessing of the user's information by a co-user, not in response to an unread e-mail message that is received by the user from the co-user.

Nielsen describes a system that informs a sender of an e-mail whether or not an e-mail sent by the sender to a recipient has been opened by the recipient. See Fig. 8 and col. 8, lines 38-

64. Such a system, however, does not provide any information to the sender about whether the sender himself/herself has unread e-mails received from the recipient and, therefore, also does not describe or suggest the above-noted features.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claim 76.

New independent claim 83 recites, among other features, determining a number of unread e-mail messages sent by the user to a first one of the co-users that remain unread by the first co-user; and conditioned on the number of unread e-mail messages being greater than zero, displaying, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have been sent by the user to the first co-user and remain unread by the first co-user. A selection of the first graphical element by the user is received and, in response to the selection, the number of unread e-mail messages sent by the user to the first co-user that remain unread by the first co-user are displayed. For at least the reasons described above with respect to claims 1 and 14, applicants submit that claim 83 and its dependent claims are patentable over the above-noted art.

New independent claim 89 recites, among other features, “receiving an indication that an e-mail message addressed to a first co-user from the user has been sent, the first co-user having no unread e-mail messages received from the first user prior to receipt of the e-mail message”, “in response to the indication, automatically displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages sent by the user to the first co-user are available for access by the first co-user,” and “wherein no graphical element related to e-mails or e-mail inbox content was displayed in the window in association with the identifier corresponding to the first co-user prior to receipt of the indication.” Applicants submit that claim 89 and its dependent claim are patentable over the above-noted art because the above-noted art does not describe or suggest these features.

New independent claim 91 recites, among other features, determining a number of unread e-mail messages sent by a first one of the co-users to the user that remain unread by the user and determining a number of unread e-mail messages sent by the user to the first co-user that remain

unread by the first co-user; and conditioned on the number of unread e-mail messages sent by the first co-user to the user being greater than zero or conditioned on the number of unread e-mail messages sent by the user to the first co-user being greater than zero, displaying, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages associated with the first co-user are available for access. A selection of the first graphical element by the user is received and, in response to the selection, at least one of the number of unread e-mail messages sent by the first co-user to the user that remain unread by the user and the number of unread e-mail messages sent by the user to the first co-user that remain unread by the first co-user are displayed. For at least the reasons described above with respect to claims 1 and 14, applicants submit that claim 91 and its dependent claims are patentable over the above-noted art.

Applicants submit that all claims are in condition for allowance.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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